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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,749

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Masahiro Karatsu

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EXAMINER

ARBES, CARL J

ART UNIT

PAPER NUMBER

3729

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,749	Applicant(s) KARATSU ET AL.	
	Examiner C. J. Arbes	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 19-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 19-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>herein</u> . | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 19-34 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Although Applicants disclose that their “agglutinant layer” (Cf. e.g. Claim 1 “may contain dielectric particles”, that the dielectric particles weight ratio of weight in the binder is less than the weight ratio in the ceramic green sheet, that the binder in the “agglutinant agent preferably belongs to the same binder group as the binder in the ceramic green sheet”, that the plasticizing agent preferably be about 0-200 weight % with respect to 100 weight parts of the binder, that the “agglutinant layer preferably contain an amount of 0.01-15 weight percent of the binder” and other specified properties Applicants fail to disclose that what is crucial to this invention what the agglutinant layer is made from. The “gist” of the invention, even though Applicants may urge that the claims are directed to a method of making a multi-layered electronic component hinges around what this so-called “agglutinant” is and how it acts to allow the method to take place.. Without explicit and clear details of what this “agglutinant layer” is made from or explicit details of where one can purchase this “layer” a PHOSITA would not be able to make or use the claimed invention. Applicants disclose. for example that they use an ampholytic surfactant such as an imidazoline system surfactant and a carboxylic acid amidine salt system surfactant and a polyalkylene glycol derivative and this can prevent static charge from generated and enable peel-off of as 3rd support sheet from the agglutinant layer. Applicants also disclose that the

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agglutinant layer is dried at a temperature between room temperature and about 80 degrees Celsius for about 1-5 minutes. But Applicants have circumvented a full and adequate disclosure that would allow a PHOSITA to make or use the invention. Applicants have not provided specific compositions, manufacturing temperatures or the like to allow a PHOSITA (someone who would be skilled in this art) to choose a “agglutinant layer” material and thus carry out their claimed invention. They merely provide broad statements of what this critically important layer may contain. It is up to the imagination of the reader to try to understand what exactly is necessary to make or use this “agglutinant layer”.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 19-34, assuming that the claims are enabling, are further rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Pat. No 2002-343674 by Kazuhiro et al (of Record); hereinafter Kazuhiro et al.

Kazuhiro et al teach a method of making a laminated ceramic capacitor. The method includes providing a binder layer (15) that is formed on a carrier film (13). The carrier film is formed onto a die lubricant layer (12). A ceramic slurry is applied to the surface where the binder layer (15) is provided so that the binder layer (15) is transferred to the green sheet (14). Another green sheet (2) or an internal electrode (18) is laminated via the binder layer (15) of the green sheet (14). (Cf. Abstract) In Para 0004 Kazuhiro et al teach that a binder, plasticizer, solvent and dielectric materials are used to carry out this invention. Such as a material such as polyester or

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polypropylene are used to form the surface (between the outer surface of the ceramic green sheet and the substrate) of the laminate. Para 0023 of Kazuhiro et al teach that polyvinyl butyral resin can act as a binder, acetic acid n-butyl can be used as a solvent, dibutyl phthalate can be added to the dielectric material, which used BaTiO₃ as a plasticizer. Kazuhiro et al also teach (Cf. Para 0025) that polyester can be used as the carrier film. It would have been obvious to provide an agglutinant layer that is attached to a release layer of a multi-layered ceramic electronic component i.e. an electronic component have a bonding strength that is less with respect to the release layer than the agglutinant layer has with respect to a support substrate. As applied to claims 2, 13 and 14 wherein applicants are reciting numerical units for the thickness of the agglutinant layer and thickness of the ceramic green sheet, it is held that these values would have been obvious to a PHOSITA and would have been so without this person using undue skill. Alternatively it is held that the limitations in these claims are mere design choices. As applied to claims 3-8, if Kazuhiro et al do not expressly teach these limitations, it would have been obvious to provide that the binders, plasticizing agents and dielectric particles would have been the same in the release layer as these materials are in the agglutinant layer inasmuch as one would attempt to try these materials at least in order to minimize the labor, materials and other costs associated with carrying out this claimed invention.

Applicants state that they do not understand the Office's position because *inter alia* the Office is not clear with its assertions. (Cf. Applicants' Remarks on page 7) The Office responds that it cannot be any more clear about how it judges Applicants disclosure and claimed invention. Applicants simply have not presented adequate disclosure to allow a Person Having Ordinary Skill In the Art (PHOSITA) to make or use the claimed invention because Applicants did not

provide enough disclosure about the “agglutinant” is. Applicants merely provide bits and pieces of what the agglutinant may contain. For example it may contain “dielectric particles”. However it may not contain these particles.. The plasticizing agent preferable contains about 0-200 weight % with respect to 100 weight parts of binder, the agglutinant layer preferably contain an amount of 0.01-15 weight percent of the binder. If anyone is not clear or precise when it comes to characterizing this invention it is Applicants’ disclosure. (Cf.. Evans v. Eaton, 20 U.S. 356, 433-34, 1822) .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. J. Arbes whose telephone number is 571-272-4563. The examiner can normally be reached on M, T, R and F from 8 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Vo, can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/C. J. Arbes/
Primary Examiner, Art Unit 3729